

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicant : Keeler, Sr.
Serial No. : 10/691,480
Filed : October 21, 2003
Title : METHOD FOR PACKAGING CRABMEAT
Conf. No. : 5040
Docket : 034-002
Examiner : Chawla
Art Unit : 1781

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

REQUEST TO REOPEN PROSECUTION

In accordance with 37 C.F.R. § 41.39(b)(1), Applicant respectfully requests that prosecution be reopened before the primary examiner. This request has been timely filed within two months of the mailing date of the Examiner's Answer, and complies with the requirements set forth in 37 C.F.R. § 1.111.

On October 13, 2011, the Examiner filed an Answer in which Claims 3–5, 7, 10, 12, 13, 15 and 18 were rejected under the doctrine of res judicata on the basis of the Board's previous decision dated May 6, 2009 in Appeal No. 2009-1587. The res judicata rejections were designated as "New Grounds of Rejection," thereby entitling Applicant to reopen prosecution. (*See* 37 C.F.R. § 41.39(b).) The res judicata rejections are respectfully traversed.

The Examiner contends that res judicata applies because the claims currently on appeal "deal with substantially the same limitations as were presented in previously appealed claims 3–5, 7, 10, 12–13, 15 and 18." (Appeal Brief, p. 24.) Applicant disagrees, and submits that res judicata does not apply.

Res judicata applies when an issue “has been definitively settled by judicial decision.” *Black’s Law Dictionary* 1425 (9th ed. 2009). The three essential elements of res judicata are (1) an earlier decision on the issue, (2) a final judgment on the merits and (3) the involvement of the same parties, or parties in privity with the original parties.

Applicant submits that the issues in the present appeal are not the same as the issues in the previous appeal. Specifically, the present appeal involves consideration of two declarations that were not considered by the Board during the previous appeal. Therefore, res judicata does not apply.

In *Ex parte Aggarwal*, the Board recently addressed the issue of res judicata, and held that:

[w]hen Appellants submit new affidavits not considered previously to make a new record, thus presenting different questions of patentability, the doctrine of *res judicata* does not apply ‘even if the claims are viewed as identical to those in the prior case.’

Ex parte Aggarwal, U.S. Ser. No. 10/041,141 (appeal 2010-011553) (citing *In re Russell*, 439 F.2d 1228, 1230 (CCPA 1971)).

In the previous appeal, the Board affirmed the examiner’s rejections. However, after the Board’s decision, Applicant submitted two declarations: (1) a declaration of John Keeler, Sr. and (2) a declaration of John Keeler, Jr. These declarations were not considered by the Board during the previous appeal. Therefore, the doctrine of res judicata does not apply.

The similarity of the previously appealed claims to the currently pending claims is of no moment. Res judicata does not apply when new evidence has been submitted “even if the claims are viewed as identical to those in the prior case.” *Id.*

In view of the declaration evidence submitted since the previous appeal, the doctrine of res judicata does not apply. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections of Claims 3–5, 7, 10, 12, 13, 15 and 18 based on the doctrine of res judicata.

All other outstanding rejections are respectfully traversed for the reasons expressed in detail in the appeal brief filed on June 21, 2011.

Respectfully submitted,

/Victor J Wasylyna/

December 5, 2011

Victor J. Wasylyna
Reg. No. 52,345

WALTERS & WASYLYNA, LLC
Post Office Box 751294
Dayton, Ohio 45475
Phone: (216) 785-0044
Fax: (216) 395-0115
E-mail: victor@wwiplaw.com

CERTIFICATE OF EFS-WEB TRANSMISSION

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office by way of the EFS-WEB electronic filing system on December 5, 2011:

/Victor J Wasylyna/

Victor J. Wasylyna